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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,754	01/27/2004	Andrew Perkins	A-75001	2266

40461 7590 01/03/2007

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EXAMINER	
TRUONG, THANH K	
ART UNIT	PAPER NUMBER
3721	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	01/03/2007	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/766,754
Filing Date: January 27, 2004
Appellant(s): PERKINS, ANDREW

Edward S. Wright
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 11, 2006 appealing from the Office action mailed March 31, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The nonstatutory double patenting rejection of claims 1-20 has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,493,684	Bolton	1-1985
5,230,453	Meschi	7-1993
6,582,800	Fuss et al.	6-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 3, 5-7, 9, 11, 13-15, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al. (6,582,800) in view of Bolton (4,493,684).

Fuss et al. discloses an apparatus and method for making a packing material in the form of a string of air-filled packing cushions with rows of perforations extending across the material between the cushions, comprising: means (43, 44) for feeding superposed layers of film material having longitudinal spaced, transversely extending rows of perforation along a path, means (89) for injecting air between the two layers of film material, means (93) for sealing the layers of film material together to form air-filled cushions between the rows of perforations.

Fuss et al. disclose the claimed invention, but did not expressly disclose the means for partially tearing the material along the edge portion of the rows of perforations to facilitate the tearing a desired number of the air-filled cushions from the string.

Bolton discloses (figures1-4) an apparatus and the method comprising: means (51) engagable with an edge portion of the material (10) for feeding the material at a predetermined speed, and a tear roller (55) having a surface that rotates faster than the predetermined speed (column 2, lines 33-35) and is intermittently engagable with the edge portion for exerting an abrupt periodic pull on the material which produces a partial tearing of the material along the rows of perforations (column 2, lines 33-35 and column 3, lines 37-39).

Bolton further discloses: the means for feeding the material at a predetermined speed comprises a feed roller (51) with a surface in continuous driving engagement with the material (figure 3); and the tear roller rotates faster than the feed roller (column 2, lines 33-35).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fuss et al. apparatus and method by incorporating the apparatus and the method for partially tearing the material along the edge portion of the rows of perforations as taught by Bolton, in order to provide means for making a packaging system which is capable of more rapid and economic operation.

3. Claims 2, 4, 8, 10, 12, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al. (6,582,800) in view of Bolton (4,493,684) and further in view of Meschi (5,230,453).

As discussed above in paragraph 6 of this office action, the combination of the references of Fuss et al. and Bolton disclose the claimed invention, but do not expressly disclose that the tear roller has an arcuate section and a section adjacent to the arcuate section, which remains out of driving engagement with the material, and the tear roller is larger in diameter than the feed roller.

Meschi discloses (figure 5) an apparatus and the method in which the tear roller (125, 126) has an arcuate section and a section adjacent to the arcuate section (127, 128), which remains out of driving engagement with the material, and the tear roller is larger in diameter than the feed roller (figure 5). The Meschi apparatus and method provides an efficient means to periodically cause a substantial tensioning on the material sheet to produce a tearing at the transversal pre-pierced straight line (column 6, lines 1-11).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Fuss apparatus and method by incorporating the tear roller as taught by Meschi, providing an efficient means to periodically cause a substantial tensioning on the material sheet to produce a tearing at the transversal pre-pierced straight line.

(10) Response to Argument

Regarding claims 1, 3, 5-7, 9, 11, 13-15, 17, 19 and 20. In response to the Appellant's argument that:

> *"There is no motivation in the references themselves or elsewhere in the prior art for combining the selected features of Fuss et al. and Bolton in the manner suggested by the Examiner. That motivation comes entirely from applicant's own disclosure and claims",*

this is not found persuasive because:

It appears Appellant is attacking the individual merits of references used in the prior art rejection and is alleging that the examiner uses hindsight construction to come up with Appellant's claimed invention. However, such attempt has been considered by the court improper. The prior art rejection under 35 USC 103 is based on combination of references taken as a whole. One cannot show non-obviousness by attacking references individually. *In re Keller*, 208 USPQ 871 (CCPA 1981). Furthermore, *In re McLaughlin*, 170 USPQ 209 (CCPA 1971) states that "[T]he test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned from applicant's disclosure, such a reconstruction is improper[.]"

In this instant case, Fuss et al. discloses the method and an apparatus for making a packing material in the form of a string of air-filled packing cushions with rows of

perforation extending across the material between the cushion as recited in the claims of the present claimed invention, and Fuss et al., column 2, lines 49-53, discloses that:

> *"Transversely extending rows of perforations 19 are formed across the tubing at longitudinally spaced intervals along the length of the tubing. These perforations separate adjacent ones of the cushions and provide means for tearing the cushions apart"* (emphasis added), and

Bolton discloses the method and an apparatus that comprising:

means engagable for partially tearing the material along the rows of perforations to facilitate tearing a desired number of the bag from the string or

intermittently engaging an edge portion of the material with a tear roller having a surface that travels faster than the predetermined speed for exerting an abrupt periodic pull on the material which produces a partial tearing along the rows of perforations as recited in the claims of the present claimed invention, and Bolton, column 2, lines 26-34, discloses that:

> *"Accordingly, there is provided a method for making a supply of **partially separated** multibag units, comprising first passing a perforated chain of side-sealed bags through a first set of driven nip rollers, then passing said chain directly to a second set of nip rollers having a partial nip of selected width less than the width of said chain, while driving said second nip rollers at a speed greater than said first nip rollers sufficient to partially separate the bags at their respective lines of perforation"* (emphasis added).

Clearly, one of ordinary skill in the art at the time of the claimed invention was made would have seen the benefit of combining the references through modifying the method and apparatus of Fuss et al. by incorporating the partially separating the bags at their respective line of perforation as taught by Bolton.

In response to the Appellant's argument that:

> *"Moreover, the teachings of Fuss et al. and Bolton would not produce a workable system even if they could be combined in the manner suggested by*

> *the Examiner. In Bolton, the bags which are pretorn are uninflated and flat when the pretearing is done, and with the rollers engaging the central portions of the bags and having to be moved into and out of contact with the bags when tearing is desired, the mechanism shown in Bolton cannot be utilized to separate inflated cushions as in applicant's invention. If someone tried to use the mechanism shown in Bolton to pretear the cushions coming out of the Fuss et al. machine, either the inflated cushions would not pass between the rollers, or if the cushions could pass, they would be ruptured or "popped" when the rollers were pressed against them"* (emphasis added),

this is not found persuasive for the following reasons:

First of all, in the Appellant presently claimed invention, the pretearing of the string of perforated air filled bags are taking place at the flat region of the string of air filled bags (see figure 1). It does not pretearing at the inflated cushions either.

Secondly, the tear rollers (56, 57) of the Appellant presently claimed invention, for intermittent engagement with the film material, also has flat faces (66), and thus rollers (56, 57) also move into and out of contact with the bag.

Finally, if one tried to use the Appellant's tearing rollers at the inflated cushion as suggested by the Appellant, it would not work either, because as the Appellant has stated above: "*the inflated cushions would not pass between the rollers, or if the cushions could pass, they would be ruptured or "popped" when the rollers were pressed against them*".

Furthermore, Bolton suggested that to partially separate the bags at their perforated line of separation, one would use the rollers that is intermittently engaging each other and the second rollers need to have a surface that travels faster than the predetermined speed of the first rollers for exerting an abrupt periodic pull on the material to produce a partial tearing along the perforated line. Therefore, one skill in the art when applying the teaching, as taught by Bolton, would apply the tearing rollers where the partial tearing is needed, in this case, at the edge of the string of perforated bags.

Regarding claims 2, 4,8, 10, 12, 16 and 18. In response to the Appellant's argument that Bolton and Meschi are not concerned with air-filled packaging cushions, the examiner would like to point out that:

Fuss et al. is relied upon for the teaching of making a packing material in the form of a string of air-filled packing cushions with rows of perforation extending across the material between the cushion.

Bolton is relied upon for the teaching of the partially tearing the material along the edge portion of the rows of perforations; and

Meschi is relied upon for the teaching of applying the tear roller that has an arcuate section and a section adjacent to the arcuate section, which remains out of driving engagement with the material.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted.

Thanh K. Truong
December 21, 2006.

Conferees:
Stephen F. Gerrity

Louis Huynh

Thanh Truong